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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/821,136 | 04/08/2004 | Viktors Berstis | AUS920040214US1 | 8956 |
| 50170 7590 09/25/2007 IBM CORP. (WIP) c/o WALDER INTELLECTUAL PROPERTY LAW, P.C. P.O. BOX 832745 RICHARDSON, TX 75083 | | | EXAMINER ALAM, MUSHFIKH I | |
| | | | ART UNIT 2623 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-----------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/821,136 | BERSTIS, VIKTORS | |
| | Examiner | Art Unit | |
| | Mushfikh Alam | 2623 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/8/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 11-20 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 11-20 define a "computer program product having a medium with a computer program embodied thereon" embodying functional descriptive material. However, the claim does not define a computer-readable medium that is executed and is thus non-statutory for that reason (i.e., "When functional descriptive material is recorded on some computer-readable

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medium and executed by a computer it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed "computer program product having a medium with a computer program embodied thereon" can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium with a computer program embodied thereon that is executed" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-2, 4-16, 20-26, 29-30, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Maissel et al. (6637029).

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Claim 1, Maissel teaches a system for screening broadcast programming, comprising:

- a viewer configured to receive broadcast programming, to receive commands from a user (selecting a channel), to receive commands from an interface (110) coupled to the viewer (television), to present the received broadcast programming to the user based on commands from the user (selecting a channel), and to present the received broadcast programming to the user based on commands from the interface (present the channel selected) (fig. 1; column 10, lines 22-38);
- a processor (130) coupled to the interface (110) and configured to receive a screening signal (viewer behavior), to receive user input from the interface (user selections), to store the received user input (in viewer profiles), to generate a local action signal (profile update) based on the user input and the received screening signal, and to transmit the local action signal to the interface (transmitting programs based on the profile updates) (fig. 1; column 12, lines 16-45, column 13, lines 9-13); and
- the interface (110) configured to receive the local action signal (profile update), to transmit commands (alert messages) to the viewer based on the local action signal (preferred programs in profile), and to receive user input from the user (selecting to tune channel in alert message), the user input comprising at least an action preference (selecting to tune to channel) (fig. 1; column 12, lines 45-61 and column 15, lines 46-55).

Claim 2, Maissel teaches the system as recited in claim 1, further comprising a broadcast recorder (DVCR) coupled to the interface and configured to receive broadcast programming, to store the received broadcast programming, to transmit the stored broadcast programming to the viewer, to receive commands from the user, and to receive commands from the interface (column 10, lines 38-53).

Claim 4, note the discussion of claim 1 above. Maissel teaches the system as recited in claim 2, wherein the broadcast recorder is further configured to transmit the stored broadcast programming to the viewer based on commands from the interface (column 10, lines 38-53).

Claim 5, Maissel teaches the system as recited in claim 1, wherein the screening signal is a real -time screening signal (user reaction in real-time) (column 18, lines 26-40).

Claim 6, Maissel teaches the system as recited in claim 1, wherein the screening signal is a precision screening signal (precise viewing behavior) (column 11, lines 56-59)

Claim 7, Maissel teaches the system as recited in claim 1, wherein the viewer is configured to present audio broadcast programming to the user (column 9, lines 4-8).

Claim 8, note the discussion on claim 1 above. Maissel teaches a system for screening broadcast programming, comprising:

- the interface configured to receive a screening signal (viewing behavior), to receive user input from the user (user selections), the user input comprising at least an action preference (preferred programs alert), to store the received user input (viewing behavior stored in

profile), and to transmit commands (alert message) to the viewer based on the user input and the received screening signal (fig. 1; column 11, lines 56-59, column 12, lines 16-59).

Claim 9, note the discussion on claim 1 above. Maissel teaches a system for screening broadcast programming, comprising:

- the interface configured to transmit the local action signal (profile updates are transmitted from set top box 110 to intelligent interface 130) (column 11, lines 48-56).

Claim 10, Maissel teaches the system as recited in claim 9, wherein: the processor is further configured to transmit the screening signal (alert based on viewer behavior) to the interface; and the interface is further configured to receive the screening signal and to transmit the screening signal (how the user has reacted to the alert) (fig. 1; column 26-40).

Claim 11 recites computer program code to perform the steps of claim 1. It is inherent that Maissel teaches computer program code to perform the steps of claim 1 as noted above.

Claim 12 recites computer program code to receive broadcast programming. It is inherent that Maissel teaches computer program code to receive broadcasting programming as noted in claim 1 above.

Claim 13 recites computer program code for presenting broadcast programming to a user. It is inherent that Maissel teaches computer program code for presenting broadcast programming to a user as noted in claim 1 above.

Claim 14 recites computer program code to perform the steps of claim 2. It is inherent that Maissel teaches computer program code to perform the steps of claim 2 as noted above.

Claim 15 recites computer program code to perform the steps of claim 2. It is inherent that Maissel teaches computer program code to perform the steps of claim 2 as noted above.

Claim 16 recites computer program code to perform the steps of claim 4. It is inherent that Maissel teaches computer program code to perform the steps of claim 4 as noted above.

Claim 20 recites computer program code to perform the steps of claim 7. It is inherent that Maissel teaches computer program code to perform the steps of claim 7 as noted above.

Claim 21, Maissel teaches a method for screening broadcast programming, comprising:

- receiving a screening signal (viewer behavior), the screening signal associated with a broadcast programming, the broadcast programming comprising at least a content of interest segment (viewer watching a program of interest) (column 11, lines 56-59 and column 12, lines 16-23);
- receiving user input from a user (modifying viewer profile), the user input comprising at least a COI segment type (program characteristic) column 12, lines 16-50); and
- generating a local action signal (updating profile) based on the screening signal and the user input (column 15, lines 46-55).

Claim 22, Maissel teaches the method as recited in claim 21, wherein the user input further comprises at least an action preference (reacting to alert message) (fig. 1; column 16, lines 26-40).

Claim 23, Maissel teaches the method as recited in claim 21, further comprising receiving broadcast programming (column 10, lines 22-38).

Claim 24, Maissel teaches the method as recited in claim 23, further comprising presenting broadcast programming to a user (column 10, lines 22-38).

Claim 25, Maissel teaches the method as recited in claim 23, further comprising storing broadcast programming (column 10, lines 22-53).

Claims 26 and 33, Maissel teaches the method as recited in claim 25, further comprising presenting stored broadcast programming to a user. Apparatus may be a DVCR (column 10, lines 38-53).

Claims 29 and 30, Maissel teaches the method as recited in claim 23, further comprising presenting broadcast programming (based on viewer profiles) to a user based on the local action signal (profile updates) (fig. 1).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 17-19, 27-28, 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maissel et al. (6637029) in view of Logan et al. (2006/0218579).

Claim 3, Maissel is silent regarding the system wherein the broadcast recorder is further configured to modify the stored broadcast programming based on commands from the interface.

Logan teaches the system wherein the broadcast recorder is further configured to modify (delete portions) the stored broadcast programming based on commands (markings) from the interface (paragraph [0049]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided markings of program segments as taught by Logan to the intelligent monitoring system of Maissel to enable users to edit stored content (paragraph [0049]).

Claims 27 and 31, Logan teaches the method further comprising presenting stored broadcast programming to a user based on the local action signal (user markings) (paragraph [0049]).

Claim 28, Logan teaches the method further comprising modifying (deleting portions) stored broadcast programming based on the local action signal (user markings) (paragraph [0049]).

Claim 32, Logan teaches the method as recited in claim 31, further comprising presenting modified stored broadcast programming to a user (paragraph [0050]).

Claim 17 recites computer program code to perform the steps of claims 27 and 31. It is inherent that Logan teaches computer program code to perform the steps of claims 27 and 31 as noted above.

Claim 18 recites computer program code to perform the steps of claim 3. It is inherent that Logan teaches computer program code to perform the steps of claim 3 as noted above.

Claim 19 recites computer program code to perform the steps of claim 28. It is inherent that Logan teaches computer program code to perform the steps of claim 28 and 31 as noted above.


Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mushfikh Alam whose telephone number is (571) 270-1710. The examiner can normally be reached on Mon-Fri: 8:30-18:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on (571) 272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA
9/13/2007



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